

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:

BILL L. DAVIS and JESSE S. WILLIAMSON

For Reissue of U. S. Patent 5,630,363
Issued May 20, 1997
Serial No. 08/515,097

Group Art Unit: 2854

Filing Date: May 20, 1999

Examiner: S. Funk
J. Hiltun

Serial No.: 09/315,796

For: **COMBINED LITHOGRAPHIC/
FLEXOGRAPHIC PRINTING
APPARATUS AND PROCESS**

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SUMMARY OF INTERVIEW - FEBRUARY 6, 2001

To: The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Bill Davis, one of the reissue applicants, together with Ray Prince and the undersigned, attended a scheduled interview with the examiner on February 6, 2001.

Prince reviewed his comments made in his Fourth Supplemental Declaration, executed September 27, 2000, concerning the RDP Marathon article, as well as his comments concerning (a) the U.S. Hartung '752 patent made in his Third Supplemental Declaration, executed September 11, 2000, (b) the file history of the opposition to EP 620,115 (counterpart of the '752 patent) made in his Fifth Supplemental Declaration, executed November 15, 2000, and (c) German Gebrauchsmuster G 93 05 552.8 (U1) made in his Sixth Supplemental Declaration, executed December 5, 2000. Prince opined that the specification and claims of the Gebrauchsmuster were non-enabling for a number of reasons.

The undersigned counsel maintained for the reasons set forth in the Fifth Supplemental Statement of Prior Art and Other Information, filed December 8, 2000 (a courtesy copy of which was provided the Examiner at the interview) that only the claims of the Gebrauchsmuster were prior art against the '363 patent. Counsel referred to *In re Tenney*, 254 F.2d 619, 624 (C.C.P.A. 1958) on this point.

Prince also reviewed the major points made in his declarations executed May 19, 1999 (original), March 25, 2000 (supplemental) and June 29, 2000 (second supplemental) that claims 42-86 [and now additional claims 94-96 and 100-102] concerning perfecting were supported by the original specification. The Examiner agreed with Prince's assessment.

Counsel emphasized the Federal Circuit case law concerning §120 entitlement and that under *In re Shaw*, 202 USPQ 285, 293 (Comm'r. Pat. 1978), *the examiner had a duty to compare the specification of Serial No. 08/435,798 with the specification of the '713 and '058 patents (U.S. Patents No. 5,760,713 and No. 6,116,058) and analyze the issue of support in the '713 and '058 patent claims in Serial No. 08/435,798*. Expert Prince indicated the necessary support was lacking, pointing to testimony in his second supplemental declaration issued June 20, 2000.

Counsel reviewed the Judgment entered by Judge Lynn in the Northern District of Texas, and indicated that he agreed findings 9-18 were supported by the record:

9. WPC is the owner of United States Patent No. 5,630,363 ("the '363 patent"). On May 20, 1999, WPC filed application serial number 09/315,796 in the United States Patent and Trademark Office ("PTO") to reissue the '363 patent ("the Reissue Application"), which is presently pending in the PTO.

10. The uncontested evidence in the record shows that, in June of 1992, Davis and Williamson conceived the invention described and claimed in the '363 patent.

11. The evidence in the record further shows that, on June 12, 1994, Davis and Williamson disclosed the invention of the '363 patent to Steve Baker ("Baker"), a salesman of PRI, telling him that they wanted to apply inks or coatings using the flexographic process upstream of or prior to printing with lithography in a continuous inline process on an offset lithographic press and that they wanted to use a retractable, interstation printer/coater having an anilox roller and chambered doctor to perform the flexographic process, and that on June 15, 1994, Baker told John W. Bird ("Bird"), product manager of PRI, the information that Davis and Williamson had disclosed to Baker on June 12, 1994.

12. WPC entered into an agreement with PRI to provide to WPC a retractable, interstation flexographic printer/coater with an anilox roller and a chambered doctor.

13. Pursuant to DeMoore's request on July 7, 1994, Rendleman, who was employed by PRI, prepared drawings of the ferris wheel, retractable flexographic printer/coater shown in Figure 2 of the '363 patent. The ferris wheel, retractable flexographic printer/coaters manufactured and delivered to WPC by PRI were paid for by WPC pursuant to the agreement between WPC and PRI.

14. On May 4, 1995, DeMoore, Rendleman and Bird filed U. S. patent application serial number 08/435,798 ("the '798 application"). The overlapping process disclosure common to the '798 application and the '363 patent and the Reissue Application originated from Davis and Williamson. The subject matter of unprosecuted method claims 24-35 of the '798 application, and narrower claims thereof, do not conflict with the '363 patent and the Reissue Application. Davis, Williamson and WPC do not claim inventorship of the claimed subject matter of claims 1-23 of the '798 application pending (allowed or on appeal) as of December 1, 2000, and the unprosecuted claims 24-35 of the '798 application, and any claims of U.S. Patents No. 5,598,777, No. 5,631,316, No. 5,960,713, and No. 6,116,158.

15. Plaintiffs no longer contend that they, individually, collectively or in any combination, is or are a sole or joint inventor of any claim of the '363 patent as issued or any of claims 1-87 of the Reissue Application pending as of December 1, 2000.

16. With respect to all claims of the '363 patent as issued and claims 1-87 of the Reissue Application pending as of December 1, 2000, priority rests in the inventive entity of Davis and Williamson and not in any entity consisting of one or more of DeMoore, Rendleman and Bird.

17. There was no fraud or inequitable conduct in the prosecution of the application that resulted in issuance of the '363 patent.

18. Based on the evidence in the record in this action, the information presently known to the parties, and the prior art and other information of record in the Reissue Application, all claims of the '363 patent as issued, and claims 1-87 of the Reissue Application, are valid, including being valid under the provisions of 35 U.S.C. §§ 102 (a), (b), (c), (e), (f) and (g) and 103.

Counsel argued that if any reasonable person in reviewing the Baker (two declarations), Bird (three declarations), Brown, Garner and reissue applicants' Rule 131 declaration and the corresponding deposition testimonies, he would agree that the findings were inescapable, and that there was a clear case of derivation on the part of PRI and DeMoore, et al. in Serial No. 08/435,798 from Davis and Williamson, based upon a restaurant meeting on June 12, 1994 in Atlanta and subsequent meetings between reissue applicants and Bird and/or Baker starting in mid-August 1994.

Counsel also indicated that Protestors belated claim to conservatorship with Rendleman in claims 15-16 was legally erroneous in view of *Micro Chemical, Inc. v. Great Plains Chemical Co.*, 194 F.3d 1250 (Fed. Cir. 1999), as it would be improper to include the ferris wheel retraction mechanism as a part of the "flexographic ink-producing means" because §112, ¶6 does not "permit

incorporation of structure from the written description beyond that necessary to perform the claimed invention." 194 F.3d at 1258.

Counsel indicated that the belated claims to the benefit of 35 U.S.C. §120 made by Protestors and DeMoore, et al. in mid-1998 to the application leading to the '713 and '058 patents came, according to their deposition testimony, well after Chairman DeMoore and Vice President Garner had learned about the '363 patent during late 1997 or early 1998. Counsel indicated that a study of the '713 and '058 file histories would show an extremely belated and ineffective citation of the '363 patent, and that it was clear that PRI and DeMoore, et al. intended to wrongfully claim the benefit of Serial No. 08/435,798 and 35 U.S.C. §120 in order to avoid citing the '363 patent in the file histories leading to the '713 and '058 patents.

Respectfully submitted,



Robert Hardy Falk
Reg. No. 27,877
FALK & FISH, L.L.P.
P.O. Box 794748
Dallas, Texas 75397
Telephone: (214) 954-4480
Facsimile: (214) 969-5941

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